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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------------|------------------------|
| 09/882,917 | 06/15/2001 | Cary Lee Bates | ROC920010074US1 | 9773 |
| 46797 | 7590 | 07/03/2007 | | |
| IBM CORPORATION, INTELLECTUAL PROPERTY LAW DEPT 917, BLDG. 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829 | | | EXAMINER LEROUX, ETIENNE PIERRE | |
| | | | ART UNIT 2161 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 09/882,917 | Applicant(s) BATES ET AL. | |
| | Examiner Etienne P LeRoux | Art Unit 2161 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Claims Status

Claims 1-26 are pending. Claims 1-26 are rejected as detailed below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9-15 and 17-26 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,785,891 (Allen et al), hereafter Allen.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Claims 1, 6, 10-15, 18, 21-23 and 26:

Allen discloses:

receiving a response containing the electronic document comprising the at least two frames each containing the searchable text [Fig 2, step 110, col 5, lines 10-20]

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automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames [Fig 2, step 120, col 5, lines 40-50]

rendering the electronic document for display wherein the designated default search frame of the displayed electronic document is available to a user for conducting a search of the searchable text contained in the designated default search frame and wherein absent a command from a user to search a different one of the at least two frames, a user request to perform a search is, by default, automatically initiated in the designated default search frame [col 5, lines 5-20]

Claims 2, 11 and 20:

Allen discloses wherein the electronic document is a web page, wherein the response is received from the Internet and wherein at least the automatically designating and rendering are performed by a browser [col 5, lines 5-20]

Claims 3 and 19:

Allen discloses wherein automatically designating occurs one of before rendering or after rendering [col 5, lines 40-50]

Claim 4:

Allen discloses wherein automatically designating occurs without an explicit selection of the default search frame by a user [col 5, lines 40-50]

Claims 5 and 7:

Allen discloses wherein automatically designating comprises parsing the response to locate a default search frame identifier [applet, col 5, lines 40-50]

Claims 9, 17 and 25:

Allen discloses highlighting the default search frame [col 5, lines 40-45]

Claim 24:

Allen discloses wherein the default search frame code segment is an attribute of a frameset tag [applet reads on frameset because applet indicates an active frame]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen.

Claims 8 and 16:

Allen discloses the elements of claim 1 as noted above but does not disclose wherein automatically designating comprises one of selecting from the at least two frames containing a greater amount of content and selecting a largest frame from the at least two frames. Official Notice is taken that automatically designating comprises one of selecting from the at least two frames containing a greater amount of content and selecting a largest frame from the at least two frames is well-known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify Allen per the above limitation for the purpose of speeding up the process of searching.

Response to Arguments

Applicant's arguments filed 4/30/2007 have been carefully considered but are not persuasive for the following reasons.

Applicant Argues:

Applicant states on page 7,
Allen does not disclose automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame.

Examiner Responds:

Examiner is not persuaded. Allen discloses in column 5, lines 40-50 the following:

At step 120 one of the visible frames is defined as an "active" frame. That is, in the case of a graphical user interface having a plurality of visible frames, **one of the visible frames is designated as an active frame by default selection or user interaction.** The active frame is that frame which provides a response, if any, to a user interaction. For example, if the active frame includes an HTML page having an applet that is being executed, a user interaction will be with that applet. Thus, user interaction with the display screen will result only in a user interaction with the applet running on the HTML page within the active frame. Typically, a user may select a different frame as the active frame by selecting that frame using an input device such as a mouse.

Allen clearly reads on the claim limitation "automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame" because Allen discloses an active frame which is selected by default.

Applicant Argues:

Applicant states on page 8 that Allen does not disclose a "search frame."

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A general purpose dictionary¹ defines searching as “to look through writings, records etc., to establish certain facts.” Examiner maintains the following disclosure by Allen, column 5, lines 5-20, reads on the above dictionary definition of searching.

The method 100 of FIG. 2 is entered at step 105 when, for example, an HTML page is accessed by a user and loaded into a viewable window via a browser program. At step 110 one or more visible frames are generated, with each visible frame being associated with a respective HTML page. That is, an HTML page is loaded into each visible frame. The resulting display of one or more visible HTML pages within respective visible frames provides, for example, a graphical user interface enabling a user to interact with a remote information provider such as a website, or with a local information source such as a Help or Information Center stored on, for example, a CD-ROM. **A viewable browser window including one hidden frame and a plurality of visible frames** will be described in more detail below with respect to FIG. 4.

Allen clearly reads on the claimed “search frame” because Allen discloses a viewable browser window containing a plurality of visible search frames such that a user can look through writings on the display screen.

Examiner maintains the following disclosure by Allen, column 6, lines 45-55, reads on a “search frame.”

At step 130, the method 100 interacts with the user. That is, at step 130 user interaction with the presently active frame or, more specifically, user interaction with an applet running within the HTML page of the presently active visible frame occurs. The user interaction may comprise the selection of an object (e.g., a radio button, a pull-down menu and the like) within a dialog box or other data structure, **the entry of text into a field supporting such entry** (with or without a confirmation via selection of an “enter” button), or other such user interaction commonly known to those skilled in the art.

Allen clearly reads on the claimed “search frame” because Allen discloses the entry of text into a field which implies that the user looked through writings in the active frame.

¹ Webster’s New World College Dictionary, Fourth Edition

Examiner maintains the following disclosure by Allen, column 7, lines 55-65, reads on a “search frame.”

At step 165, the task is performed and the results, if any, are displayed, stored in the hidden frame HTML page or otherwise utilized. Step 165 can be illustrated in the context of a simple commercial transaction. Assume that a user interface is provided a plurality of temporally successive HTML pages within a visible frame, where each of the HTML pages includes a respective applet that interacts with a user to responsively store user-supplied data in an HTML page within a hidden frame. **The user-supplied data comprises, e.g., quantity and identification of items to be purchased,** purchase price of identified items, user name, shipping address, credit card number and the like. If the task to be performed is the generation of an invoice detailing the transaction, the user-supplied data stored by each visible frame HTML page applet in the hidden frame HTML page is retrieved and then processed to generate the invoice. The processing is performed by an applet running within the last HTML page running within the visible frame (i.e., the “checkout” page). The method 100 then proceeds to step 130.

Allen clearly reads on the claimed “search frame” because Allen discloses the user supplies data such as items to be purchased which implies that the user looked through writings in the active frame.

Applicant Argues:

Regarding claim 8, Applicant states on page 10:

Applicants submit that ‘automatically designating [one of the at least two frames as a default search frame] comprises one of selecting from the at least two frames a frame containing a greater amount of content and selecting a largest frame from the at least two frames’ is not well-known and expected in the art.

Examiner Responds:

Examiner is not persuaded. US Pat No. 6,593,944 discloses in Figure 7 and col 14, lines 15-20 that the frame criteria can include, for example, selecting the frame with the largest dimensions.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Etienne LeRoux

6/26/2007


ETIENNE LEROUX
PRIMARY EXAMINER